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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/316,546	05/21/1999	JAY S. WALKER	WD2-99-012	7943
22927	7590	07/13/2006	EXAMINER	
WALKER DIGITAL 2 HIGH RIDGE PARK STAMFORD, CT 06905			KARMIS, STEFANOS	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/316,546	<b>Applicant(s)</b> WALKER ET AL.	
	<b>Examiner</b> Stefano Karmis	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. The following communication is in response to Applicant's remarks filed 25 April 2006.

### ***Status of Claims***

2. Claims 1-58 are currently pending.

Claims 1-4, 6-16, 21-44, 49-54 and 56-58 stand rejected under 35 U.S.C. 102(e) as being anticipated by Herman et al. (hereinafter Herman) U.S. Patent 6,341,353.

Claims 5, 17-20, 45-48 and 55 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Herman et al. (hereinafter Herman) in view of Tadesco et al. (hereinafter Tadesco) U.S. Patent 6,161,059.

### ***Response to Arguments***

3. Applicant's arguments filed 25 April 2006 have been fully considered but they are not persuasive. In Section C of Applicant's remarks, Applicant asserts that a claim of priority has been added to U.S. Patent Application No. 08/920,116, filed August 26, 1997, which in turn claims priority to an earlier filed application, U.S. Patent Application No. 08/822,709 filed March 21, 1997. The Examiner has reviewed both applications and did not find support for the limitations of claim 1 of the instant application. For example, instant claim 1 states "receiving an acceptance of the offer by the customer on the record of charge." Neither of the applications to which priority is claimed support this. Instead, a cashier processes an upsell by pressing a selection button on a POS terminal (see Abstract of 08/920,116). Therefore, the instant

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application's claim to priority is not supported by the either application, and therefore their filing dates are not proper dates for prior art considerations. Independent claims 6, 44, 51 and 56 are substantially similar to claim 1 and therefore follow the same reasoning of claim 1 as above regarding priority.

In Section D of the remarks, applicants states that the rejection of claims 1-58 is improper because Herman is not an appropriate reference under 102(e). However, as discussed above, Herman is appropriate prior art because the limitations of claims 1-58 are not supported in the applications in which the instant applications claims priority from.

Applicant also contests that the Official Notice is unsupported. The Official Notice was taken in the office action mailed 16 December 2004. Regarding Official Notice, the applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made (see MPEP 2144.03). If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate (see MPEP 2144.03). In the subsequent final rejection mailed 02 June 2005, the Examiner reiterated that such claims remained rejected under as previously stated under the official notice of the previous

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office action. Therefore, Applicant has failed to traverse the official notice taken by the Examiner.

Therefore claims 1-58 remain rejected as stated in the previous office action and Applicant's remarks are not persuasive.

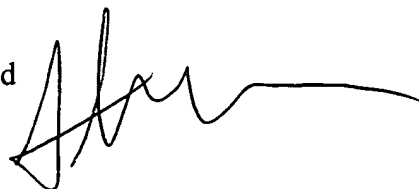
### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted  
Stefano Karmis  
10 July 2006



HANI M. KAZIMI  
PRIMARY EXAMINER